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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WEBB, GREGORY E

ART UNIT PAPER NUMBER

1751

DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS6

Office Action Summary

Application No.

09/812,605

Applicant(s)

PEARL, RICHARD E.

Examiner

Gregory E. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION***Response to Arguments***

Applicant's arguments have been considered. The examiner agrees that the claims were misread and will thus provide a second action non-final. The examiner appreciates the applicant's comments but notes that several of these references clearly teach esters beyond the isobutyl butyrate. Roelofs clearly teaches a composition in example II meeting the applicant's process compositional limitations of claim 1. Similarly, the applicant has not addressed the rejections of Yezrielev which the examiner clearly indicated other esters beyond the isobutyl isobutyrate.

The examiner further disagrees with the applicant's arguments that picking and choosing were used to anticipate the claims. The applicant has not specifically stated where or which references the examiner has applied this type of reasoning. As the applicant's claims now stand, in particular claim 1, millions of common solvents would meet the applicant's limitations. Picking and choosing is not required to meet such broadly disclosed claim limitations. In fact, these references as stated below not only directly teach the applicant esters, but do so in a clear unequivocal exemplified fashion such as in examples II, VI, VII of Roelofs or example 1, and comparative example 2 of Yezrielev. Although these references were presented in a manner incorrectly suggesting the applicant's preferred use of isobutyl isobutyrate, it is to the applicant's benefit to consider these references in whole in an effort to expedite prosecution.

Double Patenting

Previous double patenting rejections over US 6,235,694 are withdrawn as the prior art claims require the use of isobutyl isobutyrate.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Previous rejections to claims 1-10 as being anticipated by Harbin are withdrawn based on the applicant's amendments to the claims. The applicant has included the negative limitation excluding the use of hydroxides. Hydroxides are an essential component to Harbin and would thus not anticipate the instant claims.

Previous rejections to claims 1-10, and 12 as being anticipated by Dixon et al are withdrawn. The applicant has correctly argued that Dixon et al fails to teach the appropriate esters as required by the instant claims.

Claims 1-12, and 21-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Roelofs (US 5,993,562).

Roelofs teaches composition containing esters including isobutyl acetate (see col. 6, lines 53-65). Roelofs further teaches these compositions do not require a hydroxide as the pH adjusting ingredients are preferably triethanolamine (see col. 8, lines 19-44). Roelofs further teaches the use of hydroxides as an optional component and not required by the composition and teaches various example lacking any hydroxide (see col. 9, lines 24-35).

Concerning the contacting step, the substrate and the contaminant, Roelofs teaches the removal of residual paint from an interior surface (see abstract and col. 7, lines 45-55).

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In example V, Roelofs teaches the paint contaminant to be dried latex paint.

Concerning claim 5, Roelofs teaches the use of secondary solvents and water (see col. 7, lines 34-45). Concerning claims 6-12, 21-22, in example II, Roelofs teaches a composition containing water, an ester other than isobutyl isobutyrate, and a secondary solvent.

The only components required by Roelofs are an abrasive and a carrier solvent (see col. 6, lines 53-60). The amount of abrasive required by Roelofs is 1-20% of the cleaner composition (see col. 8, lines 45-64). Therefore, the solvent content, i.e. the carrier solvent, could be contained in amounts ranging from 80-99% of the composition as required by claims 23-25.

Claims 1-11, 21-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Vonk et al (US 5691290).

Vonk teaches the following paint removing composition:

"1. A cleaning composition to remove unwanted paint, graffiti or other coatings from a substrate which consists essentially of:

(1) from 40% to 90% by weight of the total composition of a five-membered ring lactam of the general formula ##STR2## in which R represents a hydrogen atom, or a methyl, an ethyl, a propyl, an isopropyl or a vinyl group, and

(2) from 10% to 60% by weight of the total composition of a glycerol triester of an aliphatic saturated monocarboxylic acid having from 1 to 4 carbon atoms; and

(3) an effective amount of up to 25 wt. % of the total composition of a member of the group consisting of diethyl phthalate, diisopropyl adipate and esters of lactic acid and a saturated aliphatic monohydric alcohol having from 1 to 4 carbon atoms.

5. A cleaning composition according to claim 1, in which the ester of lactic acid is ethyl lactate or butyl lactate.

6. A cleaning composition according to claim 1, which further consists essentially of up to 10 wt. % of the total composition of a functional additive selected from the group consisting of surfactants, thickening agents, corrosion

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inhibitors, colouring agents, deodorizing agents, moisturizers, emollients, abrasives and mixtures thereof."

Noting that butyl lactate meets the applicant's ester limitation, the lactam meets the limitation of claim 5-10, the composition contains no hydroxides.

Claims 1-11, 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilkens et al (US 5,215,675).

Wilkens teaches the following composition in claims 1 and 11:

"1. A water soluble, biodegradable paint stripping composition for the separation of a resinous coating from the surface of a substrate which consists essentially of an aqueous solution of (a) between about 10 and about 50 parts by weight water, (b) between about 3 and about 15 parts by weight peroxide and (c) between about 40 and about 70 parts by weight of ethyl lactate ; (a), (b) and (c) being combined to form 100% composition.

11. The composition of claim 1 which contains about 60 parts by weight ethyl lactate, about 0.5 parts by weight of the tetrasodium salt of ethylenediaminetetraacetic acid, about 1 part by weight N-alkyl pyrrolidone surfactant, about 3 parts by weight Na dodecyl benzene sulfonate, about 1 parts by weight ethoxylated butynediol, about 32 parts by weight aqueous H.sub.2 O.sub.2 wherein said H.sub.2 O.sub.2 is present in an amount of between about 5 and 10 parts by weight/20-30 parts by weight of water, and about 2 parts by weight organic thickener."

Noting that the ethyl lactate meets the ester limitation, the water meets the limitation of claim 12, the peroxide meets the limitation of claim 5-10, and no hydroxides are required.

Claims 1-11, and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Gaul (US 5,413,729).

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Gaul teaches in example 27 a composition containing 90% dibasic ester and 10% butyrolactone. Noting that dibasic esters contain 6 to 10 carbon atoms and are not isobutyl isobutyrate.

Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Yezrielev (US 6,280,519) for those reasons set forth in paper #4.

Claims 11, and 21-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Yezrielev (US 6,280,519).

Yezrielev teaches in table 3 a composition containing 99.5% methyl pivalate (organic ester) and 0.5% carrier solvent.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 703-305-4945.

The examiner can normally be reached on 9:00-17:30 (m-f).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to read 'Gregory E. Webb', with a large, stylized initial 'G'.

Gregory E. Webb
Primary Examiner
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gw
April 4, 2003